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MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

LOFDAHL, JORDAN M

ART UNIT PAPER NUMBER

3644

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,872

Applicant(s)

BLESER ET AL.

Examiner

Jordan Lofdahl

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Final Office action mailed 11/21/03 has been withdrawn.

Response to Arguments

Edelson et al. discloses all the structural limitations of the network as claimed, such as, a network server, an application server, a database, an intranet server as described below. The method steps of the instant claims are also readily apparent during the operation of the device of Edelson et al.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not disclose one or more distribution facilities. It does also not disclose a prescription order that connects at least one of a plurality of member pharmacies **and** one or more distribution facilities.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3644

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, recites "...transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities". This recitation of shipping to both the pharmacy and shipping facility is considered new matter and does not have support in the specification. The specification recites (page 8, last paragraph) "the user may select between either having the order shipped or may locate and select a pharmacy store for pick-up of the prescription." The user either selects the prescription to be shipped via a shipping facility or the prescription is processed and filled by personnel at the pharmacy not both. A plurality of shipping facilities is also not described in the specification.

Claim Rejections - 35 USC § 102

Claims 1 and 3-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Edelson et al. (5737539).

As to claim 1, Edelson et al. discloses a device comprising a network server (206) connected to the network (col. 44, lines 42-45) that is accessible by one or more customers (the physicians are read as customers) via the network (fig. 16); an application server connected to the network server (col. 45, lines 15-30; server (206) is capable of being a cluster of servers which uses applications. Examiner reads one of the disclosed cluster of servers capable of being an applications server); a database (210) connected to the application server, the database containing information concerning drugs and personal information concerning one or more of the customers (the professional using the system is capable of creating a prescription for him/herself); an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, the intranet being connected to the application server (col. 45, lines 15-30; server (206) is capable of being a cluster of servers which is similar to the World Wide Web and having access restricted to a limited group of authorized customers. Examiner reads one of the disclosed cluster of servers capable of being an intranet server), wherein the application server is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to transmit a prescription order to at least one of the plurality of member pharmacies and one of the one or more shipping facilities (it is inherent that if a prescription drug is shipped to a customer or a pharmacy, that the drug was shipped from a shipping facility).

As to claim 3, disclosed is prescription history (col. 14, lines 13-15).

As to claim 4, disclosed is a network server that is configured to format display of the prescription history according to a plurality of display formats (fig. 1-14).

As to claim 5, disclosed is a system where the customers can print the information.

As to claim 6, disclosed is the network capable of being the Internet.

As to claim 7, disclosed is a system wherein access to personal information concerning each of the customers includes at least one of the access and viewing of the personal information, editing of the personal information and adding additional information to the person information previously stored.

As to claim 8, disclosed is a system wherein the prescription order includes ordering a new prescription.

As to claim 9, disclosed is a method comprising the steps of accessing a network server (206) capable of hosting a network website (col. 47, lines 1-7) via the network; registering a customer with the network website (*it is inherent that a physician with a password is registered with the network*); displaying to the customer a prescription order

Art Unit: 3644

selection (fig. 1-15); displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of plurality of pharmacies and one or more distribution facilities (fig. 1-15); and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access a personal prescription history.

As to claim 10, disclosed is a method step prompting a customer to enter a customername, a password and personal profile; transmitting an entered name customername, password and personal profile information to a network server; storing the customername, password and personal profile information in the network server; and enabling the customer to access at least a portions of the website by subsequent entry of the entered customername and password.

As to claim 11, disclosed is a method step wherein the personal prescription history includes past prescriptions.

As to claim 12, disclosed is a method step wherein the order includes a new prescription order.

Art Unit: 3644

As to claim 13, disclosed are method steps of assigning the customer a person ID number subsequent to the step of registering the customer; communicating the personal ID number to the customer via a secured communication and prompting the customer to enter the personal ID number to allow the customer to access secured portions of the website (col. 17 lines 4 - col. 18 line 7).

As to claim 14, disclosed are method steps of manually entering a customers password concerning the customer into a connection to an intranet server capable of being located in one of any of a plurality of member pharmacies and one or more centralized company locations; associating the customer to a network server and information concerning the customer currently stored in the database from the intranet server and communicating at least a customername and password, which enables the customer to access the network website, to the customer via a secured communication using the customer contact information.

As to claim 15, disclosed are the method steps of enabling the customer to select one or more display formats for the personal prescription history and enabling a customer to print a specific format selected by the customer from the one or more display formats.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3644

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. (5737539).

As to claim 2, not disclosed is a system wherein the network server displays one or more interactive webpages to the one or more customers that is viewable by the one of the one or more customers. Disclosed are a variety of interface devices and networks (col. 44, lines 33-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to comprise the system of Edelson et al. with interactive webpages to create a more customer friendly interface.

As to claim 16, not disclosed is the method step of selecting the prescription to be manually picking up from a pharmacy and shipped to a designated postal address. Disclosed is the prescription being ordered from a pharmacy and it is well known in the art of ordering to have a customer pick up the item at the store or have it mailed to the customer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to comprise the method with having a selection of manually picking up the prescription from a pharmacy and being mailed to a designated postal address, to create a choice for the customer of where to pick up the prescription.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan Lofdahl whose telephone number is 703.605.1217. The examiner can normally be reached on m-f 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703.305.7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jml


TERI P. LUU
SUPERVISORY PRIMARY EXAMINER